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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,683	04/27/2001	Kazuharu Maeda	010589	9047

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WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP
1250 CONNECTICUT AVENUE, NW
SUITE 700
WASHINGTON, DC 20036

EXAMINER
WASSUM, LUKE S

ART UNIT	PAPER NUMBER
2167	

DATE MAILED: 04/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/842,683	MAEDA ET AL.
	Examiner	Art Unit
	Luke S. Wassum	2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>28 February 2006</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>12-20</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) <u>14</u> is/are allowed.

6)☒ Claim(s) <u>12,13 and 15-20</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>27 April 2001</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

       1.☒ Certified copies of the priority documents have been received.

       2.☐ Certified copies of the priority documents have been received in Application No. _____.

       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in 37

CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for

continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely

paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 27 January 2006 has been entered.

Response to Amendment

2.   The Applicants' amendment, filed 27 January 2006, has been received, entered into the

record, and considered.

3.   As a result of the amendment, claims 12, 14 and 19 have been amended. Claims 12-20

remain pending in the application.

The Invention

4.   The claimed invention is a system for allowing a user to prepare a parts check list.

Priority

5.   The Applicants' claim to foreign priority under 35 U.S.C. § 119 to Japanese Patent

Applications JP 2000-132386, filed 1 May 2000, JP 2000-143486, filed 16 May 2000, JP 2000-

200849, filed 7 July 2000, and JP 2000-209874, filed 11 July 2000, is acknowledged. The priority

papers filed under 35 U.S.C. § 119(a)-(d) supporting the Applicants' claim to foreign priority have

been received and entered into the record.

6.   The subject matter of the elected claims (12-20) corresponds only to Japanese Patent

Application JP 2000-132386. As such, the priority date established for this application is 1 May

2000.

Claim Rejections - 35 USC § 102

7.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless —
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in
> the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent
> by another filed in the United States before the invention by the applicant for patent, except that an international
> application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an
> application filed in the United States only if the international application designated the United States and was
> published under Article 21(2) of such treaty in the English language.

8.   Claims 12, 13, 15 and 18-20 are rejected under 35 U.S.C. 102(e) as being anticipated by

Costello et al. (U.S. Patent Application Publication 2002/0007225).

9.   Regarding claim 12, **Costello et al.** teaches a parts check list preparing system as claimed,

comprising:

> a) a means to store a database comprising the graphics data of a layout of a part, and the
>
>   parts data of the part (see disclosure that the system includes a database comprising
>
>   detailed parts data, the detailed data identifying each part by providing a series of
>
>   linked schematic representations of the selected assemblies and any subassemblies and
>
>   respective parts, paragraph [0088] and database 300 in Figure 8);

b) a means to fetch the graphics data of a part necessary for preparing a parts check list that

shows parts in a tabular form (see disclosure that the technical documents, including

parts catalogs, are retrieved, paragraphs [0069]-[0076], and particularly paragraph

[0076]);

c) a means to cause a layout reproduced from the graphics data of the part to be presented

on display (see disclosure of the display of graphical reproductions of parts and

assemblies, paragraph [0090] and Figure 10);

d) a means to select the part in the layout (see disclosure that parts can be selected from the

schematic diagrams, paragraphs [0011]-[0012]);

e) a means to fetch the parts data corresponding with the graphics data of the selected part

from the database (see disclosure of selection of parts through visual navigation of the

schematic diagrams, paragraph [0046]);

f) a means to arrange the parts data into a list, and to cause the list to be presented on display

together with the layout (see disclosure that detailed replacement part data is retrieved

based upon selection of specific parts in schematic diagrams, paragraph [0012]; see

also disclosure of the parts ordering module, paragraphs [0010], [0046] and [0061]);

g) a means to automatically prepare the parts check list based on the parts list (see disclosure

of the parts ordering and parts tracking system, paragraphs [0028]; see also disclosure

of the parts ordering module, paragraphs [0010], [0046] and [0061]); and

h) a means for ordering the part by transmitting the prepared parts check list based on the

parts list (see disclosure that the parts requisition center 22 and the service shop 16

may be linked via a global network, such as the Internet and the World Wide Web,

paragraph [0026]; see also disclosure that the system provides parts ordering and parts

tracking via communications with the parts requisition center 22, paragraph [0028]).

10.   Regarding claim 19, **Costello et al.** teaches a parts check list preparing system as claimed,

comprising the steps of:

> a) in addition to fetching the graphics data of a part necessary for preparing a parts checklist
>
>   that shows parts information in a tabular form from a database comprising the
>
>   graphics data of parts and the parts data thereof, causing a display device to present a
>
>   layout based on said graphics data on display (see disclosure that the technical
>
>   documents, including parts catalogs, are retrieved, paragraphs [0069]-[0076], and
>
>   particularly paragraph [0076]; see also disclosure of the display of graphical
>
>   reproductions of parts and assemblies, paragraph [0090] and Figure 10);
>
> b) after selecting the part in the layout on display, fetching the parts data corresponding with
>
>   the graphics data of the selected part from the database (see disclosure of selection of
>
>   parts through visual navigation of the schematic diagrams, paragraph [0046]);
>
> c) arranging the acquired parts data into a list and causing the display device to present the
>
>   list together with the layout (see disclosure that detailed replacement part data is
>
>   retrieved based upon selection of specific parts in schematic diagrams, paragraph
>
>   [0012]; see also disclosure of the parts ordering module, paragraphs [0010], [0046] and
>
>   [0061]);
>
> d) automatically preparing the parts check list based on the parts list (see disclosure of the
>
>   parts ordering and parts tracking system, paragraphs [0028]; see also disclosure of the
>
>   parts ordering module, paragraphs [0010], [0046] and [0061]); and
>
> e) ordering the parts by transmitting the prepared parts check list based on the parts list (see
>
>   disclosure that the parts requisition center 22 and the service shop 16 may be linked

via a global network, such as the Internet and the World Wide Web, paragraph [0026];

see also disclosure that the system provides parts ordering and parts tracking via

communications with the parts requisition center 22, paragraph [0028]).

11.   Regarding claim 13, **Costello et al.** additionally teaches a parts check list preparing system

comprising a network server and a network terminal connected with each other via a network (see

paragraph [0025], the network server comprising:

      a) a server's memory means to store the title of layouts of parts, the graphics data of the

           layouts, and the parts data of those parts (see disclosure of the repair information

           vault, paragraph [0044]);

      b) a layout title acquiring means to acquire the title of a layout arbitrarily chosen by the

           network terminal (see disclosure of the repair information vault, paragraph [0044]);

      c) an information searching means to search through the server's memory means for the

           graphics data corresponding with the acquired title of the layout, and the parts data of

           the part reproduced from the graphics data of the layout title (see disclosure of the

           repair information vault, paragraph [0044]); and

      d) an output delivering means to deliver, as output, the searched graphics data and parts data

           to the network terminal, and to cause the display device of the network terminal to

           present the layout reproduced from the graphics data (see disclosure of the display of

           graphical reproductions of parts and assemblies, paragraph [0090] and Figure 10);

      and the network terminal comprising:

      e) a terminal's memory means to store the graphics data and parts data provided from the

           layout displayed on the terminal's display device (see disclosure that the system

includes a database comprising detailed parts data, the detailed data identifying each

part by providing a series of linked schematic representations of the selected

assemblies and any subassemblies and respective parts, paragraph [0088] and database

300 in Figure 8; see also disclosure that the technical documents, including parts

catalogs, are retrieved, paragraphs [0069]-[0076], and particularly paragraph [0076]);

f) a layout data acquiring means to acquire the graphics data of a part selected from the

layout displayed on the terminal's display device (see disclosure of selection of parts

through visual navigation of the schematic diagrams, paragraph [0046]);

g) a parts list preparing means to search through the terminal's memory means for the parts

data corresponding with the graphics data just acquired (see disclosure that detailed

replacement part data is retrieved based upon selection of specific parts in schematic

diagrams, paragraph [0012]; see also disclosure of the parts ordering module,

paragraphs [0010], [0046] and [0061]);

h) a parts list delivering means to deliver the parts data thus acquired to the display device

and to insert the parts data into the parts list displayed together with the layout (see

disclosure that detailed replacement part data is retrieved based upon selection of

specific parts in schematic diagrams, paragraph [0012]; see also disclosure of the parts

ordering module, paragraphs [0010], [0046] and [0061]); and

i) a parts check list preparing means to prepare a parts check list based on the part data in

the parts list (see disclosure of the parts ordering and parts tracking system,

paragraphs [0028]; see also disclosure of the parts ordering module, paragraphs [0010],

[0046] and [0061]).

12.   Regarding claim 15, **Costello et al.** additionally teaches a parts check list preparing system wherein the server's memory means stores a price table containing price data of each part (see disclosure that the cost of the part is maintained, in claim 18), and a storage table containing a storage data of each part (see disclosure of the availability of a part, paragraph [0046]), and wherein the network server comprises a response preparing means which searches through the price table and storage table for the price data and storage data of the parts listed in the parts check list and makes the parts check list reflect the search result (see disclosure of the parts ordering module, paragraphs [0010], [0046] and [0061]).

13.   Regarding claim 18, **Costello et al.** additionally teaches a parts check list preparing system wherein the part is a constitutive element of a construction machine (see disclosure that the system can be used for any type of equipment, such as trucks, ships, off-road vehicles, airplanes, etc., paragraph [0025]).

14.   Regarding claim 20, **Costello et al.** additionally teaches a parts check list preparing system embodied in a computer program in a computer-readable storage medium (see paragraph [0002]).

Claim Rejections - 35 USC § 103

15.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

16.   The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966),

that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a)

are summarized as follows:

    1.   Determining the scope and contents of the prior art.

    2.   Ascertaining the differences between the prior art and the claims at issue.

    3.   Resolving the level of ordinary skill in the pertinent art.

    4.   Considering objective evidence present in the application indicating obviousness or
        nonobviousness.

17.   This application currently names joint inventors. In considering patentability of the claims

under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was

commonly owned at the time any inventions covered therein were made absent any evidence to the

contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and

invention dates of each claim that was not commonly owned at the time a later invention was made

in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35

U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

18.   Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Costello et al.** (U.S.

Patent Application Publication 2002/0007225) as applied to claims 12, 13, 15 and 18-20 above, and

further in view of **Rune** (U.S. Patent 6,304,913).

19.   Regarding claim 16, **Costello et al.** teaches a parts check list preparing system substantially

as claimed.

Costello et al. does not explicitly teach a parts check list preparing system wherein at least

two servers different in communications distances to the network terminal are introduced, wherein

the network terminal gains access to a network server shorter in communications distance.

Rune, however, teaches a system wherein at least two servers different in communications

distances to the network terminal are introduced, wherein the network terminal gains access to a

network server shorter in communications distance (see col. 2, lines 7-12).

It would have been obvious to one of ordinary skill in the art at the time of the invention to

access the network server with the shorter communications distance, since this would improve

response times (see col. 1, lines 54-57).

20.   Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Costello et al. (U.S.

Patent Application Publication 2002/0007225) and Rune (U.S. Patent 6,304,913) as applied to claim

16 above, and further in view of Gladney et al. (U.S. Patent 4,714,992)

21.   Regarding claim 17, Costello et al. and Rune teach a parts check list preparing system

substantially as claimed.

Neither Costello et al. nor Rune explicitly teach a parts check list preparing system wherein

the network server shorter in communication distance checks whether or not any alteration is

introduced in the graphics data and/or parts data stored in the network server longer in

communications distance and wherein it updates its own graphics data and/or parts data in

accordance with the alteration whenever it finds an alteration is introduced.

Gladney et al., however, teaches a system wherein a database is replicated to one or more replicas, and obsolescence of the replicas is managed by having the replica locations submit requests to the source location for ascertaining obsolescence of the data objects, and wherein the source location transmits up-to-date data objects to the replica having obsolete data objects (see col. 2, lines 49-66).

It would have been obvious to one of ordinary skill in the art at the time of the invention to synchronize data between a server and any replicas, since without a means of synchronization the data contained in any replicas would diverge from that of the server, thus providing incorrect data to requesting users.

Allowable Subject Matter

22.   Claim 14 is allowed.

Response to Arguments

23.   Applicant's arguments filed 27 January 2006 have been fully considered but they are not persuasive.

24.   Regarding the Applicants' argument that the new limitation (means for ordering...) of claims 12 and 19 distinguishes over the prior art, the examiner respectfully disagrees.

Costello et al. clearly discloses at paragraph [0026] that orders are communicated from the repair facility to the parts requisition center, as discussed in the rejections above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke S. Wassum whose telephone number is 571-272-4119. The examiner can normally be reached on Monday-Friday 8:30-5:30, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

In addition, INFORMAL or DRAFT communications may be faxed directly to the examiner at 571-273-4119. Such communications must be clearly marked as INFORMAL, DRAFT or UNOFFICIAL.

Customer Service for Tech Center 2100 can be reached during regular business hours at (571) 272-2100, or fax (571) 273-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Luke S. Wassum
Primary Examiner
Art Unit 2167

lsw
14 April 2006